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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,683	08/29/2002	Doris Lorraine Buck		2101

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EXAMINER

HENDRICKS, KEITH D

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 02/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/081,683	BUCK, DORIS LORRAINE	
	Examiner	Art Unit	
	Keith Hendricks	1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 6) ☐ Other:

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DETAILED ACTION

Specification

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading.

Content of Specification

- (a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.
- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
- (c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.
- (d) Incorporation-By-Reference Of Material Submitted On a Compact Disc: The specification is required to include an incorporation-by-reference of electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application. See 37 CFR 1.52(e) and MPEP § 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text were permitted as electronic documents on compact discs beginning on September 8, 2000.

Or alternatively, Reference to a "Microfiche Appendix": See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.

- (e) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:
 - (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."

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- (2) Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."
- (f) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.
- (g) Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
- (h) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.
- (i) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).
- (j) Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).

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NOTE: While it appears that applicant's invention is positively and concisely set forth in the specification pages as they now stand, they should be presented in the format as stated above, with the headings used whenever applicable. While applicant may be tempted to further describe their invention, or describe it in a different manner, applicant should be careful not to introduce any new matter into the disclosure (i.e., matter which is not supported by the disclosure as originally filed).

NOTE: Also, while technically not incorrect, the abstract of the application should be in the format described below. It appears that the current abstract is in the form of an advertisement, but should simply be a clear, concise description of the invention that is to be found and further described within the specification.

Applicant is reminded of the proper content of an abstract of the disclosure. A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive details should not be given.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

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Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The elements which make up the composition must be clearly and positively specified. The elements must be organized and correlated in such a manner as to present a complete operative composition. The claim(s) must be in one sentence form only. Note the format of the claims as found in the cited U.S. Patents, and/or as suggested by the examiner immediately following the rejections below.

In claim 1:

- The phrase "What I claim as my invention is", in claim 1, should be deleted from claim 1, and inserted before the entire set of claims.
- The labeling description of "Doris Lorraine's 'Peanut Butter Batter' Pancake Mix" improperly contains reference to a commercial product. The scope of the claims as they stand cannot be ascertained, and the labeling description is not supportive or germane to the claim itself. For example, if the company is ever sold, or if the ingredients change slightly over time, then the scope of the claims may be unintentionally changed.
- The phrase "including, but not limited to", is taken to mean "comprising", a commonly used and court-defined patent term. It is suggested that this phrase be amended to the term "comprising".
- The phrase "integrated into a pancake mix" is indefinite and incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. It is unclear as to the relative connection between the peanut ingredients and the pancake mix. It is also unclear if the peanut ingredients alone are to be "integrated into a pancake mix", without any other components, and if so, how this would be done. It is noted that this is not supported by the specification, and thus the claims must be amended to more clearly recite the invention.
- The phrase "also makes waffles and crepes" does not appear supportive or germane to the claimed invention itself, namely the mix composition.

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Claims 2-5:

The phrase "can be used for" the various recited purposes, does not clearly further define the invention from independent claim 1. The phrase "can be used for" is simply a potential state, and does not change the mixture of claim 1. It is believed that applicant is attempting to claim a method of using the mix of claim 1 to produce the varied products. If so, then the claims must be amended to reflect the statutory category of invention of a "method of use".

Suggested claim 1:

Claim 1. A peanut butter batter pancake mix, which comprises:

- (a) a combination of peanut ingredients comprising peanut flour, peanut butter, peanut chunks, peanut oil, and peanut extract; and
- (b) a flour-based pancake mixture.

It is important to note that this claim is merely a suggestion by the examiner, based upon that which applicant appears to be attempting to claim, and based upon the disclosure of the specification. This suggestion provides guidance for proper claim structure and language.

Noting the claim rejections above, each of the dependent claims 2-5 are suggested to follow the format as shown below.

Suggested claim 2:

Claim 2. A method of using the peanut butter batter pancake mix of claim 1, comprising forming doughnuts with the peanut butter batter pancake mix as a base.

Note that, alternatively, dependent claims 2-5 could be written as a "method of making" the various products, but a more precise description of the actual method step performed would be necessary, beyond a simple statement of "comprising using the base to produce...". This is not descriptive of the "use" step.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

i) Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (US PAT 4,057,654), in view of Watson (British Patent Application 27,554), Universal Blanchers, and the article from The Peanut Journal & Nut World.

Smith teaches the production of a baked and ground mixture of raw wheat germ, flour, fat and soluble carbohydrate. This 'prebake' is used as a component for various standard dry food mixes. "The prebake when ground has been used as an ingredient in cakes, muffins, doughnuts, pancakes, and other products" (col. 4, ln. 7-9). Example 2 of the reference discloses a "peanut wheat germ prebake", which, among other ingredients, comprises peanut butter, chopped peanuts, sugar, flour, and wheat germ. It is used as an ingredient in baking mixes, and may be further mixed with other baking components, such as flour. This patent does not disclose the use of peanut flour, peanut oil or peanut extract.

Watson discloses the production of peanut flour, and its subsequent mixture with "ordinary white flour", for the production of various foodstuffs such as bread (pg. 1, ln. 26-29).

The "Universal Blanchers" article entitled "Peanut Oils and Peanut Extracts", states that "roasted peanut extract is offered as a flavor enhancer for baking, ice cream, confectionary applications and other flavor systems." It is a "100% natural extractive peanut oil product", which "has a peanut flavor and aroma several times stronger than roasted peanuts." The "extract has broad acceptance by flavor companies as a foundation flavor in formulating... dry flavor mixes."

The Peanut Journal & Nut World article entitled "Peanuts for shortening in bakery products" discloses the use of a form of peanut butter within various bakery products, including "bread, rolls, pastries, and quick breads" (col. 2), or "biscuits, hot cakes, waffles, cornbreads" (col. 3). The peanut butter was present as a partial substitute for shortening, since it provided peanut oil/fat to the foodstuffs.

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Thus, it would have been obvious to one of ordinary skill in the art to have produced "peanut butter" pancakes -- which were generally known in the art as stated by both Smith and the Peanut Journal article -- additionally containing chopped peanut chunks, peanut flour, peanut oil and peanut extract. Each of these ingredients was known in the art for use in flour-based food mixes, as shown by the secondary references. Both Smith and the Peanut Journal article provide the teaching of several known uses for peanut products. As the secondary references also provide teachings of these components within bakery-type mixes and products, it would not have involved an inventive step for one of ordinary skill in the art to have combined the additional components into a peanut butter pancake batter mix. Furthermore, peanut butter inherently contains peanut oil, and often contains peanut 'chunks', and thus these would have been included in the mix described in Smith. The use of peanut oil and peanut extract would have been obvious to include, as peanut chunks and peanut flour are often produced having a bland taste, lacking peanut flavor and aroma.

Attention is invited to *In re Levin*, 84 USPQ 232 and the cases cited therein, which are considered in point in fact situation of the instant case. At page 234, the Court stated as follows:

This court has taken the position that new recipes or formulas for cooking food which involve the addition or elimination of common ingredients, or for treating them in ways which differ from the former practice, do not amount to invention, merely because it is not disclosed that, in the constantly developing art of preparing food, no one else ever did the particular thing upon which the applicant asserts his right to a patent. In all such cases, there is nothing patentable unless the applicant by a proper showing further establishes a coaction or cooperative relationship between the selected ingredients which produces a new, unexpected and useful function. *In re Benjamin D. White*, 17 C.C.P.A. (Patents) 956, 39 F.2d 974, 5 USPQ 267; *In re Mason et al.*, 33 C.C.P.A. (Patents) 1144, 156 F.2d 189, 70 USPQ 221.

Thus, while the various peanut ingredients instantly claimed may not have been previously combined within a pancake mix, each of the ingredients were known and commonly used in flour-based mixes which were used for various food applications. The instant claims do not appear to provide any unexpected property ("a coaction or cooperative relationship between the selected ingredients which produces a new, unexpected and useful function"), as each of the ingredients contributes its known and expected properties to the mix.

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ii) Claims 2 and 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (US PAT 4,057,654), in view of Watson (British Patent Application 27,554), Universal Blanchers, and the article from The Peanut Journal & Nut World, taken as cited in the above rejection, and further in view of the Payne article (Peanut Flour).

Payne discloses the "development, manufacture and utilization" of peanut flour. At page 286, the reference discloses the use of peanut flour with white wheat flour to make bread (col. 2), and also states that the flour may be used "in baking to increase the protein content, as an extender and binder in meat" products, and "as a base material in dry soup concentrate" (col. 3).

The use of flour-based products and other dry baking, pancake or biscuit mixes for use in other applications, such as that of making bread, doughnuts, soups, sauces and as coatings for meat products, was well known and documented in the art. The substitution of peanut flour or other peanut products within these foodstuff mixes was also known, as shown by Payne, as well as the other cited references. Thus the alternative use of a peanut ingredient-containing pancake mix to form doughnuts, soup mixes, or as a coating on meat products, would have been obvious to one of ordinary skill in the art, in light of the combined teachings of the references, as well as the state of the ordinary level of skill in the art, and would not have involved an inventive step.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith Hendricks whose telephone number is (571) 272-1401. The examiner can normally be reached on M-F (8:30am-6pm); First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-0987.


KEITH HENDRICKS
PRIMARY EXAMINER